

REMARKS

Reconsideration of this application is respectfully requested.

Applicants acknowledge the allowability 20-31 as indicated in the Office Action.

Applicants note that the Office Action states that claims 20-39 are allowable. However, claims 32-40 were previously canceled and are not pending. Clarification is requested. Further, the Office Action indicates that claim 42 would be allowable if amended to include all of the limitations of the base claim. Claim 42 has been amended accordingly and **Applicants submit that claim 42 is now in condition for allowance.**

Amendments to the Claims

The Examiner's response to Applicants' comments on the restriction requirement are noted. In particular, Applicant notes that the claims have been examined as if restricted to taxanes. As previously proposed, independent claims 1, 4, 8, 13 and 41 have been amended to recite the taxane class of anti-tumor drugs. As a result, Applicants submit that the pending claims are all in line with the restriction requirement. Further, in light of the Examiner's comments regarding the restriction requirement, claims 25-27 and 30-31 are understood to be reinstated.

Claims 3, 7, 12 and 19 are currently amended to recite ¹¹C-paclitaxel and ¹¹C-docetaxel. Other species of taxanes are still within the scope of the independent claims. The Office Action states that there is no prior art has been found directed to ¹¹C-paclitaxel and ¹¹C-docetaxel. (Office Action, page 8, paragraph 12.) Accordingly, **Applicants submit that claims 3, 7, 12 and 19 are also now in condition for allowance.**

Claim 20 has been amended to insert a comma at line 8, as requested in the Office Action. Applicants submit that this amendment is not for reasons of patentability and, therefore, does not further limit the scope of **allowable claim 20.**

The Office Action rejects claims 43-49 under 35 U.S.C. § 112 as being indefinite, pointing out that it appears these claims should depend from claim 42 rather than claim 41.

Appropriate correction has been made. **Because claim 42 is now in condition for allowance, Applicants submit that claims 43-49 are also in condition for allowance.***

Rejections Under 35 U.S.C. § 103

The February 24, 2004 Office Action rejects claims 1-19 and 41-49 under 35 USC 103(a) as obvious over U.S. Patent No. 5,981,564 to Pagé In view of U.S. Patent No. 6,441,225 to Li and in further view of an article by Schribel. However, in consideration of the amendments described above and accompanying remarks, Applicants submit that the rejection is now moot with respect to claims 3, 4, 7, 12, 19, and 42-49. For the reasons previously of record, Applicants traverse the rejection of claims 1, 2, 5, 6, 8-11, 13-18, and 41 on the grounds that a *prima facie* case of obviousness has not been established. However, in order to advance prosecution, Applicants have amended the claims to further point out the differences between the references and the present application.

On page 4, in the second paragraph after item 7, the Office Action states that “Pagé et al disclose paclitaxel derivatives having an increased solubility in water.” On page 5, the Office Action states that “Li et al disclose water-soluble compositions of paclitaxel . . . [and] that their compositions provide water soluble taxoids that overcome the drawbacks associated with the insolubility of the drugs themselves.” (emphasis added) Thus, in addition to the reasons previously of record, both the Office Action and Li et al. admit that the compositions disclosed by Li et al. are different than the drug itself, thus acknowledging a distinction between those compositions and the present claimed application and obviating a *prima facie* case of obviousness. Specifically, Li et al. teaches away from the use of its compositions for the drugs themselves, water-insoluble taxanes. For this additional reason, the Office Action fails to establish a *prima facie* case of obviousness.

To more clearly point out the differences between the cited references and the present application, claims 1, 4, 8, 13 and 41 have been amended to refer to “insoluble taxanes,” as supported by the specification at, for example, page 3, line 5. A person skilled in the art would not be motivated to utilize the methods of Pagé, which are on their face limited to specific water

* At page 4, paragraph 7, the Office Action groups claims 42-49 among the claims rejected under 35 USC 103(a). However, the Office Action Summary, and paragraph 9 on page 8 indicate that claim 42, as amended, is allowable. It is presumed that this is correct and, therefore, claims 42-49 should now be in condition for allowance. Clarification is respectfully requested.

soluble taxane derivatives, for the claimed insoluble taxanes of the present invention. Moreover, even if one were to combine Li and Pagé, one would not arrive at methods using insoluble taxanes. Accordingly, the present claims are not *prima facie* obvious in view of the cited references.

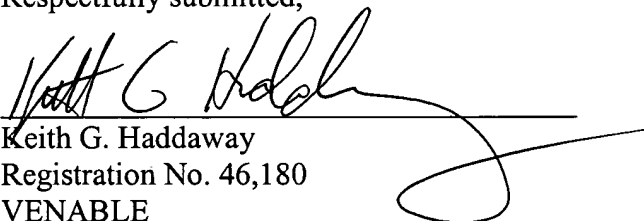
CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner indicate the allowability of claims 1-31 and 41-49 and the application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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